REMARKS

Claims 1-26 are all the claims pending in the application.

Applicants have amended claim 1 to clarify that the thermoplastic label claimed therein comprises a cold glue adhesive on the first side of the first skin layer.

Applicants have amended claims 12, 22, and 23 to clarify that the term COC's includes cyclic olefin polymers and cyclic olefin copolymers, as defined at page 8, line 13.

Applicants have amended claims 20-21 to correct an inadvertent antecedent basis issue.

I. Paragraph No. 2: Rejection Under 35 U.S.C. § 112

Claims 1-23 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Applicants have amended the claims. Accordingly, the withdrawal of this §112 rejection is respectfully requested.

II. Paragraph No. 4: Rejection Under 35 U.S.C. § 102

Claims 1, 3, 11-21 and 24 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by U.S. Patent No. 6,150,013 to Balaji, *et al.* ("Balaji").

Applicants' Response

Applicants respectfully traverse.

Applicants have amended claim 1 to clarify that the claimed thermoplastic label comprises a cold glue adhesive on the first side of the first skin layer.

As for original claim 24, it was already directed to a thermoplastic label comprising (a) a first skin layer and (b) a cold glue. The Examiner has taken the position that the limitation in original claim 24 of "a cold glue applied to the first side of the first skin layer" is a method of

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production that is not given weight in the determination of the patentability of a product. Although Applicants agree that the determination of the patentability of a product depends on the product itself and not on its method of production, the plain meaning of original claim 24 is that the claimed thermoplastic label comprises a first skin layer (a) and a cold glue (b) on the first side of the first skin layer. While the Examiner may choose to ignore the term "applied" as pertaining to the method of forming the cold glue (b) on the first side of the first skin layer (a) (How was cold glue (b) formed on first skin layer (a)? It was applied thereon.), the Examiner cannot ignore that claim 24 is directed to a thermoplastic label comprising two elements: a first skin layer (a) and a cold glue (b) on the first side of first skin layer (a).

In short, claims 1 and 24 are each directed to a thermoplastic label comprising a first skin layer (a) and a cold glue (b) on the first side of first skin layer (a).

At the top of page 3 of the Action, the Examiner asserts that Balaji "discloses a thermoplastic label comprising a first skin layer ... wherein the first skin layer ... is cavitated wherein the first side of the first skin layer is adapted to be used in contact with a cold glue adhesive."

Applicants respectfully disagree.

Balaji does not disclose, and is in fact completely silent about, a cold glue adhesive. Balaji is silent about a cold glue adhesive, Balaji is silent about a cold glue adhesive on a first side of a first skin layer, and Balaji is silent about a first skin layer adapted to be used in contact with a cold glue adhesive.

Instead, Balaji relates to *an in-mold label film* comprising at least one heat seal layer for bonding the film to a polymer substrate (Applicants refer to Balaji's abstract and to the summary of Balaji's invention at column 2). With in-mold labeling, a polymeric label stock is combined with heat-activatable adhesive, and blow-molded parisons are expanded against the molding surface and the in-mold label, which activates and bonds the heat-activatable adhesive to the blow plastic substrate or container (*see*, column 1, lines 47-59). Balaji's heat-seal layer is the so-

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called heat-activatable adhesive that allows the label to bond to a substrate (*see*, column 2, lines 56-57).

Thus, none of Balaji's layers, including Balaji's heat-seal layer, is adapted to be used in contact with any adhesive, and certainly not a cold glue adhesive.

Furthermore, although Balaji broadly states that "each of the layers of the film including the skins may contain voids," Balaji specifically states that "preferably, the skin layer and/or the heat seal layers contain essentially no voids" (Applicants refer to column 3, lines 53-60). Thus, it may be reasonable to conclude that Balaji teaches away from cavitated first skin layer (a).

For each of the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw this §102 rejection.

III. Paragraph No. 6: Rejection Under 35 U.S.C. § 103

Claims 2, 4-8, 10, and 22-23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Balaji.

Applicants' Response

Applicants respectfully traverse.

Each of claims 2, 4-8, 10, and 22-23 depends, either directly or indirectly, from present claim 1. Balaji does not anticipate or render obvious the invention of present claims 2, 4-8, 10, and 22-23 at least for the reason that Balaji does not anticipate or render obvious the invention of present claim 1, as is explained in greater detail below.

As mentioned at section II of this response, claim 1 is drawn to a thermoplastic label comprising a first skin layer (a) and a cold glue adhesive (b) on the first side of first skin layer (a).

Balaji does not disclose, *i.e.*, anticipate, claim 1 for the reasons presented at section II.

Balaji also fails to suggest, *i.e.*, render obvious, the subject matter of present claim 1.

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In this regard, the motivation or suggestion to make the claimed invention and the reasonable expectation of success must be found in the prior art, and not based on Applicants' disclosure (*see*, MPEP § 2143 and In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991). Balaji's complete silence regarding cold glue adhesive, and a cold glue adhesive on a first side of a first skin layer, makes it impossible for Balaji to motivate or suggest to a person of ordinary skill in the art to modify Balaji's disclosure in order to arrive at the presently claimed invention.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this §103 rejection.

IV. Paragraph No. 7: Rejection Under 35 U.S.C. § 103

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Balaji in view of U.S. Patent No. 5,223,315 to Katsura, *et al.* ("Katsura").

Applicants' Response

Claim 9 depends indirectly from claim 1. The combined disclosures of Balaji and Katsura do not render obvious the invention of claim 9 at least for the reason that the combined disclosures of Balaji and Katsura do not render obvious the invention of claim 1.

In this regard, Katsura, like Balaji, is completely silent with respect to cold glue adhesive. Thus, Katsura cannot cure the deficiencies of Balaji. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this §103 rejection.

V. Paragraph No. 8: Rejection Under 35 U.S.C. § 103

Claims 25-26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Balaji in view of U.S. Patent No. 5,897,722 to Bright ("Bright").

Applicants' Response

Applicants respectfully traverse.

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AMENDMENT
U.S. Appln. No. 09/770,960

Claims 25 and 26 are drawn to the following structure: a label comprising a cavitated first skin layer; a cold glue adjacent to the first side of the first skin layer; and a container having a surface that is adjacent to the cold glue, wherein the cold glue, as mentioned, is also adjacent to the first side of the first skin layer.

The Examiner concedes that Balaji fails to disclose a cold glue adjacent to the surface of the container. The Examiner has taken the position, however, that it would have been obvious "to have provided a cold glue to the surface of the container in Balaji et al. as suggested by Bright in order to adhere a label to the surface of the container."

Applicants respectfully disagree.

A proper analysis under §103 requires, *inter alia*, consideration of whether the prior art would have suggested to those of ordinary skill in the art that the prior art should be modified in order to arrive at the claimed invention. Applying the law to the present case, the issue becomes: is a person of ordinary skill in the art motivated by Bright to modify Balaji in the manner proposed by the Examiner in order to arrive at the present invention?

Applicants respectfully submit that a person of ordinary skill in the art is not motivated by Bright to modify Balaji in the manner proposed by the Examiner in order to arrive at the present invention.

In this regard, there are certain limitations on the scope of a proposed modification to the prior art. One such limitation is the rule that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious (*see*, In re Ratti, 123 USPQ 349 (CCPA 1959)). In other words, a prior art reference may not be modified so as to destroy its teachings.

The assertion that it would have been obvious to have provided a cold glue to the surface of the container in Balaji et al. as suggested by Bright in order to adhere a label to the surface of the container is an example of this type of improper modification or combination.

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Specifically, Balaji relates to in-mold labeling. Balaji's in-mold label films are bonded to a substrate by a heat-activated adhesive layer, such as Balaji's heat-seal layer. The very nature of in-mold labeling prohibits the proposed modification of bonding an in-mold label film to a substrate via a cold glue adhesive.

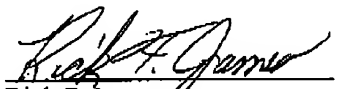
Incidentally, for this very reason, the combination of Balaji and Bright would also fail to render obvious the invention of pending claims 1-24.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw this §103 rejection.

VI. Conclusion

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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AMENDMENT
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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. (AMENDED) A thermoplastic label for use with a cold glue adhesive, comprising:

a. a first skin layer comprising a thermoplastic and a first cavitating agent, wherein the first skin layer has a first side and a second side, and the first skin layer is cavitated; and ~~wherein the first side of the first skin layer is adapted to be used in contact with~~

b. a cold glue adhesive on the first side of the first skin layer.

12. (AMENDED) The thermoplastic label of claim 1, wherein the first cavitating agent is selected from the group consisting of polyamides, polybutylene terephthalate, polyesters, acetals, acrylic resins, nylons, solid preformed glass spheres, hollow preformed glass spheres, metal beads, metal spheres, ceramic spheres, calcium carbonate, ~~COC's~~ cyclic olefin polymers, cyclic olefin copolymers, and mixtures thereof.

20. (AMENDED) The thermoplastic label of claim 1, wherein the thermoplastic is polypropylene and the polypropylene comprises homopolymer polypropylene.

21. (AMENDED) The thermoplastic label of claim 1, wherein the thermoplastic is polypropylene and the polypropylene comprises homopolymer polypropylene and wherein the cavitating agent comprises at least about 25% by weight of the first skin layer.

22. (AMENDED) The thermoplastic label of claim 4, wherein the second cavitating agent is selected from the group consisting of polyamides, polybutylene terephthalate, polyesters,

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acetals, acrylic resins, solid preformed glass spheres, hollow preformed glass spheres, metal beads, metal spheres, ceramic spheres, calcium carbonate, ~~COC's~~ cyclic olefin polymers, cyclic olefin copolymers, and mixtures thereof.

23. (AMENDED) The thermoplastic label of claim 4, wherein the second cavitating agent is selected from the group consisting of polybutylene terephthalate, calcium carbonate, ~~and COC's~~ cyclic olefin polymers, and cyclic olefin copolymers.

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